

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE



In re Patent Application of)

Jean-Michel BERNARDON)

Application No.: 09/619,584)

Filed: July 19, 2000)

For: BICYCLIC AROMATIC COMPOUNDS)

Group Art Unit: 1616

Examiner: S. N. Qazi

Confirmation No.: 1988

DECLARATION UNDER 37 C.F.R. § 1.132

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

I, **BERNARDON Jean-Michel**, hereby states as follows:

1. I was awarded a BTS in Chemistry from the University of PARIS (XVième) France, in 1970
2. I was a CHEMISTRY MANAGER in the department of MEDICINAL CHEMISTRY at GALDERMA R&D.
3. My curriculum vitae, research experience and list of publications are attached hereto as Appendix I.

4. I am aware that the Examiner in the above-identified application has concluded that claims 40-52 contain subject which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. I respectfully disagree with this conclusion.

5. I have reviewed the specification of the above-identified patent application. Based on 25 years of research in the Chemistry, it is my professional opinion that one of ordinary skill in the art, having read the specification, would have been enabled to make and/or use the invention defined in claims 40-52 without engaging in undue experimentation. That is, before the effective filing date of the above-identified patent application, those of ordinary skill in the art were aware that compounds of the type claimed exhibit properties that make them suitable for treating the various diseases disclosed in the specification, including keratinization disorders such as, for example, common acne, a comedone, a polymorphonuclear leukocyte, rosacea, nodulocystic acne, acne conglobata, senile acne, secondary acne, ichthyosis, a ichthyosisiform state, Darier's disease, paloplantar keratoderma, a leucoplasias state, a leucoplasiform state, cutaneous lichen, mucous (buccal) lichen, a disorder bearing on differentiation and proliferation, a disorder with an inflammation and/or immunoallergic compound, psoriasis, psoriatic rheumatism, cutaneous atopy, respiratory atopy and gingival hypertrophy, defined in claims 45-52. Additionally, in my expert opinion, one of ordinary skill in the art would have been enabled to make and/or use the compositions defined in claims 40-44. That is, before the filing date of the above-identified patent application, those of ordinary skill in the art were aware of conventional methods for making and/or using compositions like the novel compositions of claims 40-44.

6. To support my opinion, I have conducted a search for technical references that show that the compounds of the type defined in method claims 45 - 52 were known to exhibit properties useful in treating the claimed disorders before the above-identified patent application was filed. I also conducted a search for technical references that show that methods for making and/or using compositions

like those defined in claims 40-44 were well known before the above-identified patent application was filed.

7. The following references "THE RETINOIDS, *Biology, Chemistry and Medecine*, 2nd Edition, Edited by M.B.Sporn, A.B.Roberts,ands D.S.Goodman.Raven Press Ltd, New York, 1994, page 631-658", show that retinoids were known to exhibit properties useful in treating or inhibiting keratinazation disorders such as, for example, the various disorders identified in claims 45-52. The references show also that methods of making and/or using compositions similar to those defined in claims 40-44 were well known before the above-identified patent application was filed. Additionally, many patents have been applied before the above-identified patent application was filed, on bicyclic aromatic compounds having retinoid activity, for example US 5,763,487, US 6,156,750, US 5,935,585, US 6,171,603. Copies of these references are attached hereto in Appendix II.

8. Based on my professional experience and in view of the above-identified references, I believe that a person of ordinary skill in the art, having read the specification of the above-identified patent application, would have been enabled to make and/or use the invention defined in claims 40-52 without undue experimentation.

I HEREBY DECLARE that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Date: 9-08-2003

Bernardon Jean Michel (Name of Declarant)